

REMARKS

The Specification has been amended in a manner which does not introduce new matter or warrant a new search. Claims 10, 13, 21, 28, and 32 have been canceled without prejudice or disclaimer as to the subject matter recited therein. Claims 1, 11, 12, 14, 15, 20, 22, 24, 27, 29-31, and 33-37 have been amended. Claims 1-9, 11, 12, 14-20, 22-27, 29-31, and 33-39 remain pending in the captioned case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Allowable Subject Matter

Claims 38 and 39 were allowed. Applicant sincerely appreciates the Examiner's recognition of the patentable subject matter recited in claims 38 and 39 and awaits allowance of the remaining claims in the case. In addition, claims 13, 21, 28, 29 and 31 were objected to as being dependent upon rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response thereto, this paper amends independent claims 1, 14, 22, 27 and 37 to include the allowable subject matter recited in claims 13, 21, 28, 38 and 39. As such, the Applicant respectfully requests allowance for independent claims 1, 14, 22, 27 and 37, and all claims dependent therefrom.

Section 112, 1st Paragraph, Rejections

Claim 4 was rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement, and more specifically, for claiming subject matter which was not described in the Specification in such a way as to enable one skilled in the art to make or use the invention. Claim 4 recites, in part, "...wherein the text-based markup language is hypertext markup language (HTML) or extensible markup language (XML)." The Office Action admits that the claimed formats (HTML/XML) are, in fact, mentioned in the Specification (Office Action, page 2).

However, further statements in the Office Action suggest that "[t]he specification discloses an invention that relies heavily on DOM trees, which were known to interact with HTML/XML documents. It is not apparent from the specification how one of ordinary skill in the art would adapt these claimed formats to work with a DOM tree, or the instant invention." (Office Action, page 2). The Applicant

respectfully disagrees with the Examiner's position of a non-compliance with the enablement requirement, as will be described in more detail below.

The Federal Circuit has repeatedly held that "the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) Nevertheless, not everything necessary to practice the invention need be disclosed. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. See, e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). MPEP 2164.08

Contrary to the above Office Action statements, the Specification does provide adequate description of the claimed subject matter, which would enable one skilled in the art to make or use the invention, given the level of knowledge and skill in the art, and without undue experimentation. For example, on page 5, lines 8-14, the Specification discloses:

Each document includes one or more elements, and is expressed in a first digital format (e.g., a text-based markup language such as HTML or XML). The transcoder proxy assigns a unique identifier to each element of the electronic document... and produces an 'original script' including... the elements within [at least a] portion of the electronic document, as well as the identifiers assigned to the elements.

The Specification also discloses, "[t]he transcoder proxy may form a model of a logical structure of the electronic document... and may use the model to produce the original script." (Specification, page 5, lines 17-19). The model (i.e., DOM) is described in the Specification as including the elements within the portion, as well as the identifier assigned to each element. *See*, e.g., Specification, page 6, lines 1-3. The Specification further discloses, "[t]he model may also define methods for accessing and manipulating the document", where such methods may include using the identifier to access the model. *See*, e.g., Specification, page 8, lines 4-23.

In this manner, the Specification describes how elements (e.g., paragraphs, hypertext links, lists, tables, images, etc.) of an electronic document, such as an HTML or XML document, are assigned unique identifiers for the purpose of arranging the elements in a "tree-like logical structure" of the document, thereby forming a "document object model", or DOM. Such disclosure provides adequate description of the subject matter in claim 4 so as to enable one of ordinary skill in the art to make or use the invention without "undue experimentation". Consequently, a more highly detailed description of the

specific manner in which HTML or XML elements are arranged into DOM structures is not necessary to comply with the enablement requirement. Accordingly, removal of the §112, first paragraph, rejection of claim 4 is respectively requested.

Section 103 Rejections

Claims 1-4, 6-12, 14-20, 22-27, 30 and 32-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,748,186 to Raman (hereinafter “Raman”) and “Extensible Server Pages (XSP) Layer 1” by Stefano Mazzocchi (hereinafter “Mazzocchi”). Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Raman, Mazzocchi, and in view of the Applicants Admitted Prior Art. In light of the amendments made herein, which insert allowable subject matter into independent claims 1, 14, 22, 27 and 37, Applicants assert that the current rejection of independent claims 1, 14, 22, 27 and 37, and the claims dependent therefrom, has been obviated . Claim 32 has been canceled rendering rejection thereto moot. The rejection of independent claim 30 will be addressed in more detail below.

To establish a case of *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (C.C.P.A 1974); MPEP 2143.03. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP 2143.01. The cited art does not teach or suggest each and every limitation of independent claims, some distinctive limitations of which are set forth in more detail below.

None of the cited art teaches or suggests a system comprising: i) a transcoder proxy configured to form a pre-transcoded DOM representing a logical structure of an electronic document, and ii) a client machine configured to form a transcoded DOM representing a portion of the electronic document. Amended independent claim 30 recites, in part:

A system for delivering an electronic document, comprising: a transcoder proxy, including: a synchronous document object model (DOM) generator coupled to receive the electronic document in a first digital format... wherein the synchronous DOM generator is configured to: form a pre-transcoded DOM representing a logical structure of the electronic document... and a client machine coupled to receive the original script, wherein the client machine comprises...a user agent... configured to: form a transcoded

DOM... wherein the transcoded DOM is a representation of the portion of the electronic document...

Independent claim 30 was only amended to correct antecedent basis; thus, the amendments to claim 30 do not introduce new matter or warrant a new search.

The presently claimed case teaches a system and method for delivering electronic documents (12, FIG. 2), via a transcoder proxy (28), to a client machine (22) having limited resource capabilities. The client machine may be, for example, a palmtop or handheld computer or a wireless communication device with limited memory, display and/or processing capability, among other things. The transcoder proxy receives the document in a first digital format, and produces a pre-transcoded DOM (38), i.e., a representation of the logical structure of the electronic document, to facilitate navigation through the document. In order for the electronic document to be provided to the client machine, a portion of the electronic document is translated (by the transcoder proxy) from the first digital format to a script expressed in a second digital format. The script may include, for example, a subset of the first digital format, converted graphics images, audio files, transcoded Braille, and/or unformatted text. Upon receiving the original script, the client machine produces a transcoded DOM (42), which contains a representation of the elements within the portion of the electronic document. As such, the presently claimed case discloses the use of two separate DOMs – one (located at the transcoder proxy) containing a representation of the electronic document, and the other (located at the client) containing a representation of a portion of the document. *See, e.g., Specification, pages 11-13.*

Raman discloses “a system [that] can interactively present electronically encoded multi-media information in a plurality of presentation modalities.” (Raman, column 2, lines 19-21). In particular, the system of Raman includes a retriever (120, FIG. 1) for receiving a source document (111) as a stream of digitally encoded signals, e.g., ASCII characters, or a “first digital format.” The system of Raman further includes a recognizer (130) for parsing the character stream into fundamental source “elements” (e.g., title, sections, sub-sections, paragraphs, sentences, links, forms, etc.), and generating a nested list representing the source document. Raman discloses that the elements within the nested list can be stored within a data structure (200, FIG. 2) in the form of a hierarchical attributed tree, or “DOM”. The system of Raman further includes a presenter (140) for converting the data structure, or DOM, into multi-modal presentations, such as aural information (141), visual information (142) or tactile information (143). (*See, e.g., Raman, column 3, lines 1-13, column 4, lines 39-64.*) Raman, however, does not teach or suggest that data structure 200 is produced within a transcoder proxy, as presently claimed.

In addition, Raman simply fails to teach or suggest that another DOM, and more specifically, a DOM representing only a portion of the document, could be produced by a client machine. Instead, and as noted above, the only DOM structure disclosed by Raman (i.e., data structure 200) is converted by presenter 140 into the “multimodal presentations,” which are provided to the user as aural, visual or tactile information. Consequently, Raman does not teach or suggest a system comprising: i) a transcoder proxy configured to form a pre-transcoded DOM representing a logical structure of an electronic document, and ii) a client machine configured to form a transcoded DOM representing a portion of the electronic document, as taught in present claim 30. Accordingly, Raman does not teach or suggest all limitations of present claim 30.

Furthermore, Mazzocchi cannot be combined with Raman to overcome the deficiencies therein. Mazzocchi discloses a method for transforming a source document from a first digital format (e.g., XML) into a second digital format (e.g., XSP) by applying a “logic sheet” to insert programming code into the source document. (*See, e.g.*, Mazzocchi, pages 3-6). Though Mazzocchi briefly mentions the phrase “DOM tree” (almost in passing), Mazzocchi does not teach or suggest that the DOM tree is produced by a transcoder proxy, nor does he teach or suggest that another DOM, and more specifically, a DOM representing only a portion of the document, could be produced by a client machine. Consequently, Mazzocchi does not teach or suggest all limitations of present claim 30.

For at least the reasons set forth above, none of the cited art, either separately or in combination, provides motivation to teach or suggest all limitations of claim 30. Therefore, claim 30 and claims dependent therefrom are asserted to be patentably distinct over the cited art. As noted above, amended independent claims 1, 14, 22, 27, and 37 contain allowable subject matter. Accordingly, removal of this rejection is respectfully requested.

CONCLUSION

This response constitutes a complete response to all issues raised in the Office Action mailed July 31, 2003. The prior art made of record, but not relied upon, is not considered pertinent to the Applicant’s disclosure. If the Examiner has any questions, comments, or suggestions, the undersigned earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5468-02200.

Respectfully submitted,



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